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REMARKS

Claims 1, 4, 5, 7, 8, 10-12, 15, 16, 18, 19, 21-23, 26, 27, 29, 30, and 35-39 stand rejected under 35 U.S.C § 102(e) as being anticipated by Gallick (U.S. Patent No. 6,678,359). To anticipate under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Gallick must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Gallick must enable Applicants' claims. Gallick does not meet either requirement and therefore does not anticipate Applicants' claims.

Gallick Does Not Disclose Each and Every Element of Applicants' Claims

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Independent claim 1 claims:

A method for identifying a particular callee, said method comprising:

detecting, at a destination device, a voice utterance of a callee; and

identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.

The Office Action states that Gallick discloses "identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call" at column 3, lines 64-67 and column 6, lines 3-14, 51-56. Column 3, lines 64-67 actually states: "If, however, the individual answering the call at the called facility

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has been identified that identity will be transmitted back to the calling subscriber.” Column 6, lines 3-14 discloses using voice identification software to analyze the speech of an answering party at the called facility. Column 6, lines 51-56 discloses capturing utterances of the called party and sending caller verification routines for an attempted identification of the called party. Gallick does not disclose “identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call” as claimed in the present application. In fact, Gallick does not even mention anywhere a callee identity transmittable as an authenticated identity. Gallick does not even address authentication. Therefore, Gallick does not disclose each and every element of independent claim 1 and does not anticipate claim 1. Independent claim 1 is patentable and should be allowed.

Dependent claims 2-11 depend from independent claim 1 and include all of the limitations of claim 1. Because Gallick does not disclose each and every element of claim 1, Gallick does not disclose each and every element of claims 2-11. Gallick therefore does not anticipate claims 2-11. Claims 2-11 are also patentable and should be allowed.

Gallick Does Not Disclose Each and Every Element of
Independent Claims 12 and 23

Independent claims 12 and 23 claim a system and computer program product corresponding to method claim 1. More particularly, independent claims 12 and 23 claim system and computer program products for identifying a particular callee. The Office Action rejects claims 12 and 23 on the same grounds as claim 1. In response, Applicants respectfully note that for the same reasons that Gallick does not disclose each and every element of claim 1, Gallick does not disclose each and every element of claims 12 and 23. Gallick therefore does not anticipate system and computer program products claims 12 and 23, respectively, and claims 12 and 23 are also patentable and should be allowed.

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Dependent claims 13-22 and 24-34 depend from independent claims 12-23 respectively and include all of the limitations of claims 12 and 23. Because Gallick does not disclose each and every element of claims 12 and 23, Gallick also does not disclose each and every element of dependent claims 13-22 and 24-34. Gallick therefore does not anticipate claims 13-22 and 24-34 and claims 13-22 and 24-34 are patentable and should be allowed.

Gallick Does Not Disclose Each And Every Element of Independent Claim 35

Gallick does not disclose each and every element of claim 35. Independent claim 35 claims:

A method for identifying a callee, said method comprising:

detecting a biometric input at a biometric enabled destination device;

identifying a callee identity associated with said biometric input at said destination device, such that said callee identity is transmittable as an authenticated identity of said callee for a call."

The Office Action states that Gallick discloses detecting biometric input at a biometric enabled destination device at Figure 1, Figure 2b, column 1, line 50-column 2, line 11, column 3, lines 64-67 and col. 6, lines 3-14, 51-56. Figure 1 of Gallick actually sets forth a block diagram of a communications system. Figure 2b actually sets forth a flow chart illustrating the method described in part at column 6, lines 3-14 and 51-56. Column 1, line 50-column 2, line 11 actually discloses identifying a person answering the phone by use of a speech sample. Column 3, lines 64-67 actually states: "If, however, the individual answering the call at the called facility has been identified that identity will be transmitted back to the calling subscriber." Column 6, lines 3-14 discloses using voice identification software to analyze the speech of an answering party at the called facility.

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Column 6, lines 51-56 discloses capturing utterances of the called party and sending caller verification routines for an attempted identification of the called party. None of the cited Figures or cited columns of Gallick disclose detecting a biometric input at a biometric enabled destination device. In fact, Gallick never even mentions biometric input or biometric enabled destination devices. Gallick therefore cannot anticipate independent claim 35.

The Office Action also states that Gallick in column 3, lines 64-67 and col. 6, lines 3-14, 51-56 discloses identifying a callee identity associated with said biometric input at said destination device, such that said callee identity is transmittable as an authenticated identity of said callee for a call. Column 3, lines 64-67 actually states: "If, however, the individual answering the call at the called facility has been identified that identity will be transmitted back to the calling subscriber." Column 6, lines 3-14 actually discloses using voice identification software to analyze the speech of an answering party at the called facility. Column 6, lines 51-56 discloses capturing utterances of the called party and sending caller verification routines for an attempted identification of the called party. Gallick does not disclose "identifying a callee identity associated with said biometric input at said destination device, such that said callee identity is transmittable as an authenticated identity of said callee for a call" as claimed in the present application. In fact, Gallick does not even mention anywhere a callee identity transmittable as an authenticated identity. Gallick does not even address authentication. Therefore, Gallick does not disclose each and every element of independent claim 35 and does not anticipate claim 35. Independent claim 1 is patentable and should be allowed.

Dependent claim 36 depends from independent claim 35 and includes all of the limitations of independent claim 35. Because Gallick does not disclose each and every element of independent claim 35, Gallick does not disclose each and every element of dependent claim 36 and does not anticipate claim 38. Claim 36 is therefore also patentable and should be allowed.

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Gallick Does Not Disclose Each and Every Element of Independent Claims 37 and 39

Independent claims 37 and 39 claim system and computer program product claims corresponding to method claim 35. More particularly, independent claims 37 and 39 recite system and computer program product for identifying a callee. Claims 37 and 39 stand rejected for the same reason as independent claim 35. Because Gallick does not disclose each and every element of method claim 35, Gallick does not disclose each and every element of claims 37 and 39 and therefore does not anticipate claims 37 and 39. Claim 37 and 39 are therefore also patentable and should be allowed.

Dependent claim 38 depends from independent claim 37 and includes all of the limitations of independent claim 37. Because Gallick does not disclose each and every element of independent claim 37, Gallick does not disclose each and every element of dependent claim 38 and does not anticipate claim 38. Claim 38 is therefore also patentable and should be allowed.

Gallick Is Not An Enabling
Disclosure of Applicants' Claims

There are two required aspects of anticipation. Not only must Gallick disclose each and every element of the claims of the present invention within the meaning of *Verdegaal* in order to anticipate the claims, but Gallick must also be an enabling disclosure of the claims of the present invention within the meaning of *In re Hoeksema*. The Appellants' claims in *Hoeksema* were rejected because an earlier patent disclosed a close structural similarity to appellant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." The meaning of *Hoeksema* for the present case is that to anticipate under 35 USC 102(e) Gallick must

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place one of skill in the art in possession of Applicants' claims.

Gallick does not enable independent claim 1. Independent claim 1 claims:

A method for identifying a particular callee, said method comprising:

detecting, at a destination device, a voice utterance of a callee; and

identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.

The Office Action states that Gallick discloses at column 3, lines 64-67 and column 6, lines 3-14, and 51-56, the element "identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call." Column 3, lines 64-67 actually states: "If, however, the individual answering the call at the called facility has been identified that identity will be transmitted back to the calling subscriber." Column 6, lines 3-14 discloses using voice identification software to analyze the speech of an answering party at the called facility. Column 6, lines 51-56 actually discloses capturing utterances of the called party and sending caller verification routines for an attempted identification of the called party. Gallick does not disclose "identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call" as claimed in the present application. In fact, Gallick does not even mention anywhere a callee identity transmittable as an authenticated identity. Gallick does not even address authentication. Therefore, Gallick does not place one of skill in the art in possession of independent claim 1 and does therefore not anticipate claim 1. Independent claim 1 is patentable and should be allowed.

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Dependent claims 2-11 depend from independent claim 1 and include all of the limitations of claim 1. Because Gallick does not place one of skill in the art in possession of claim 1, Gallick does not place one of skill in the art in possession of claims 2-11. Gallick therefore does not anticipate claims 2-11. Claims 2-11 are also patentable and should be allowed.

Gallick Does Not Enable
Independent Claims 12 and 23

Independent claims 12 and 23 claim a system and computer program product corresponding to method claim 1. More particularly, independent claims 15 and 30 claim system and computer program products for identifying a particular callee. The Office Action rejects claims 12 and 23 on the same grounds as claim 1. In response, Applicants respectfully note that for the same reasons Gallick does not place one of skill in the art in possession of claim 1, Gallick does not place one of skill in the art in possession of claims 12 and 23. Gallick therefore does not anticipate system and computer program products claims 12 and 23, respectively, and claims 12 and 23 are also patentable and should be allowed.

Dependent claims 13-22 and 24-34 depend from independent claims 12-23 respectively and include all of the limitations of claims 12 and 23. Because Gallick does not place one of skill in the art in possession of claims 12 and 23, Gallick does not place one of skill in the art in possession of claims 13-22 and 24-34. Gallick therefore does not anticipate claims 13-22 and 24-34. Claims 13-22 and 24-34 are also patentable and should be allowed.

Gallick Does Not Enable Independent Claim 35

Gallick is not an enabling disclosure of independent claim 35. Independent claim 35 claims:

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A method for identifying a callee, said method comprising:

detecting a biometric input at a biometric enabled destination device;

identifying a callee identity associated with said biometric input at said destination device, such that said callee identity is transmittable as an authenticated identity of said callee for a call."

The Office Action states that Gallick discloses detecting a biometric input at a biometric enabled destination device at Figure 1, Figure 2b, column 1, line 50-column 2, line 11, column 3, lines 64-67 and col. 6, lines 3-14, 51-56. Figure 1 of Gallick actually sets forth a block diagram of a communications system. Figure 2b actually sets forth a flow chart illustrating the method described in part at column 6, lines 3-14 and 51-56. Column 1, line 50 – column 2, line 11 actually discloses identifying a person answering the phone by use of a speech sample. Column 3, lines 64-67 actually states: "If, however, the individual answering the call at the called facility has been identified that identity will be transmitted back to the calling subscriber." Column 6, lines 3-14 discloses using voice identification software to analyze the speech of an answering party at the called facility. Column 6, lines 51-56 actually discloses capturing utterances of the called party and sending caller verification routines for an attempted identification of the called party. None of the cited Figures or cited columns of Gallick disclose detecting a biometric input at a biometric enabled destination device. In fact, Gallick never even mentions biometric input or biometric enabled destination devices. Gallick therefore cannot place one of skill in the art in possession of independent claim 35 and does not anticipate claim 35.

The Office Action also states that Gallick discloses identifying a callee identity associated with said biometric input at said destination device, such that said callee identity is transmittable as an authenticated identity of said callee for a call at column 3, lines 64-67 and col. 6, lines 3-14, 51-56. Column 3, lines 64-67 actually states: "If, however, the individual answering the call at the called facility has been identified that identity will be transmitted back to the calling

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subscriber.” Column 6, lines 3-14 actually discloses using voice identification software to analyze the speech of an answering party at the called facility. Column 6, lines 51-56 discloses capturing utterances of the called party and sending caller verification routines for an attempted identification of the called party. Gallick does not disclose “identifying a callee identity associated with said biometric input at said destination device, such that said callee identity is transmittable as an authenticated identity of said callee for a call” as claimed in the present application. In fact, Gallick does not even mention a callee identity transmittable as an authenticated identity. Gallick does not even address authentication. Therefore, Gallick does not place one of skill in the art in possession of independent claim 35 and does not anticipate claim 35. Independent claim 35 is patentable and should be allowed.

Dependent claim 36 depends from independent claim 35 and includes all of the limitations of independent claim 35. Because Gallick does not place one of skill in the art in possession of independent claim 35, Gallick does not disclose each and every element of dependent claim 36 and does not anticipate claim 38. Claim 36 is therefore also patentable and should be allowed.

Gallick Does Not Disclose Enable Independent Claims 37 and 39

Independent claims 37 and 39 claim system and computer program product claims corresponding to method claim 35. More particularly, independent claims 37 and 39 recite system and computer program product for identifying a callee. Claims 37 and 39 stand rejected for the same reason as independent claim 35. Because Gallick does not place one of skill in the art in possession of claim 35, Gallick does not place one of skill in the art in possession of claims 37 and 39 and therefore does not anticipate claims 37 and 39. Claim 37 and 39 are therefore also patentable and should be allowed.

Dependent claim 38 depends from independent claim 37 and includes all of the limitations of independent claim 37. Because Gallick does not place one of skill in the

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art in possession of independent claim 37, Gallick does not place one of skill in the art in possession of dependent claim 38 and does not anticipate claim 38. Claim 38 is therefore also patentable and should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 2, 13, and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Bartholomew et al. (U.S. Patent No. 6,167,119). Claim 3, 14, and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of McAllister (U.S. Patent No. 6,101,242). Claims 6, 17, and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Timonen et al. (U.S. Pub. No. 2002/0058494). Claims 9 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Baker (U.S. Patent No. 5,533,109). Applicants respectfully traverse each rejection. Not one of the proposed combinations can establish a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Gallick and Bartholomew, McAllister, Timonen, or Baker. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Gallick and Bartholomew, McAllister, Timonen, or Baker. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Gallick and Bartholomew, McAllister, Timonen, or Baker must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The proposed combinations of Gallick and Bartholomew, McAllister, Timonen, or Baker do not

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establish even a prima facie case of obviousness and therefore cannot support a rejection under 35 U.S.C. 103. The rejections should therefore be withdrawn and the case allowed.

Gallick and Bartholomew

Claims 2, 13, and 24 stand rejected under 35 U.S.C § 103(a) as unpatentable over Gallick in view of Bartholomew. The combination of Gallick and Bartholomew cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 2, 13, and 24, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

No Suggestion or Motivation to
Combine of Gallick and Bartholomew

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Gallick and Bartholomew. *In re Vaech*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). There is no suggestion or motivation to combine Gallick and Bartholomew, because Bartholomew teaches away from the combination. Teaching away from the claims and the proposed combination is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Independent claim 1 claims method for identifying a particular callee that includes “identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.” Bartholomew discloses using an intermediary intelligent peripheral (‘IP’)—not a destination device and therefore, teaches away from Applicants’ claims. *See for example*, Bartholomew, column 11, line 62 – column 12, line 50. As such, the proposed combination of Gallick and Bartholomew cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the case allowed.

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No Reasonable Expectation of Success

In the Proposed Combination of Gallick and Bartholomew

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Gallick and Bartholomew. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There is no reasonable expectation of success to combine Gallick and Bartholomew because the proposed modification of Gallick changes the principle of operation of Gallick. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Bartholomew discloses an intermediary intelligent peripheral—not a destination device. *See for example*, Bartholomew, column 11, line 62 – column 12, line 50. To modify Bartholomew to teach "identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call," would change the stated principle operation of Bartholomew. The proposed combination and Gallick and Bartholomew therefore cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the case allowed.

The Combination of Gallick and Bartholomew

Do Not Teach All of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Gallick and Bartholomew must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claims 2, 13, and 24 include a callee identity "transmittable as an authenticated identity of said callee for a call." It was demonstrated above, that Gallick does not teach this limitation. Bartholomew also does not teach this limitation. Bartholomew discloses a communications network with intelligent peripherals, but does not address callee identities transmittable as

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authenticated identities of callees for calls. As such, the combination of Gallick and Bartholomew cannot establish a prima facie case and the rejection should be withdrawn.

Gallick and McAllister

Claim 3, 14, and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of McAllister (U.S. Patent No. 6,101,242). The combination of Gallick and McAllister cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 2, 13, and 24, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

No Suggestion or Motivation to
Combine of Gallick and McAllister

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Gallick and McAllister. *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). There is no suggestion or motivation to combine Gallick and McAllister, because McAllister teaches away from the combination. Teaching away from the claims and the proposed combination is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Independent claim 1 claims method for identifying a particular callee that includes “identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.” McAllister discloses an intermediary intelligent peripheral—not a destination device and therefore teaches away from Applicants’ destination device. *See for example*, McAllister, column 12, line 47 – column 13, line 35. As such, the proposed combination of Gallick and McAllister

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cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the case allowed.

No Reasonable Expectation of Success

In the Proposed combination of Gallick and McAllister

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Gallick and McAllister. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There is no reasonable expectation of success to combine Gallick and McAllister because the proposed combination changes the principle of operation of McAllister. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). McAllister discloses an intermediary intelligent peripheral. *See for example*, McAllister, column 11, line 62 – column 12, line 50. To modify McAllister to teach "identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call," would change the principle operation of McAllister. The proposed combination and Gallick and McAllister therefore cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the case allowed.

The Combination of Gallick and McAllister

Do Not Teach All of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Gallick and McAllister must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claims 2, 13, and 24 include a callee identity "transmittable as an authenticated identity of said callee for a call." It was demonstrated above, that Gallick does not teach this limitation. McAllister discloses a

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communications network with intelligent peripherals, but does not disclose callee identities transmittable as authenticated identities of callees for calls. As such, the combination of Gallick and McAllister cannot establish a prima facie case and the rejection should be withdrawn.

Gallick and Timonen

Claims 6, 17, and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of Timonen et al. (U.S. Pub. No. 2002/0058494). The combination of Gallick and Timonen cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 6, 17, and 28, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination of Gallick and Timonen
Do Not Teach All of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Gallick and Timonen must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Rejected claims 6, 17, and 28 depend from independent claims 1, 12, and 23 and include the limitations "identifying, at said destination device, a callee identity associated with said utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call," "means for identifying a callee identity associated with said voice utterance at said destination device, a callee identity associated with said utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call," or "means, recorded on said recording medium, for identifying a callee identity associate with said voice utterance at said destination device,."

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As discussed above, Gallick discloses using voice identification software to analyze the speech of an answering party at the called facility and sending caller verification routines for an attempted identification of the called party. Gallick, column 6, lines 3-14. Gallick does not disclose "identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call" as claimed in the present application. In fact, Gallick does not even mention anywhere a callee identity transmittable as an authenticated identity. Gallick does not even address authentication. Timonen does not teach what Gallick lacks. Instead, Timonen at Figure 3 and page 6, paragraphs 0055, 0056 discloses an encrypted message containing a digital signature sent to a third party. Such an encrypted message is not identifying, at said destination device, a callee identity associated with said utterance. In fact, a destination device is not even mentioned in the cited sections of Timonen. Because the combination of Gallick and Timonen does not teach each and every limitation of claims 6, 17, and 28, the combination of Gallick and Timonen cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the case allowed.

No Suggestion or Motivation to Modify Gallick or
Combine of Gallick and Timonen

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Gallick. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Gallick must come from the teaching of Gallick itself and the Examiner must explicitly point to the teaching within Gallick suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed.

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Cir. 1989). There is no teaching in either Gallick or Timonen disclosing "identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call" as claimed in the present application because neither reference discloses this limitation. As discussed above, Gallick discloses using voice identification software to analyze the speech of an answering party at the called facility and sending caller verification routines for an attempted identification of the called party. Gallick, column 6, lines 3-14. Timonen at Figure 3 and page 6, paragraphs 0055, 0056 discloses an encrypted message containing a digital signature sent to a third party. Such an encrypted message is not identifying, at said destination device, a callee identity associated with said utterance. In fact, a destination device is not even mentioned in the cited sections of Timonen. There is therefore no teaching in Gallick or Timonen suggesting the proposed combination. As such, the proposed combination of Gallick and Timonen cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the case allowed.

No Reasonable Expectation of Success

In the Proposed combination of Gallick and Timonen

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Gallick and Baker. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There is no reasonable expectation of success to combine Gallick and Timonen to disclose "identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call" as claimed in the present application because neither reference discloses the limitation. As discussed above, there is no teaching in either Gallick or Timonen disclosing this limitation and therefore their combination cannot together work to achieve what neither reference teaches alone. As such, the proposed combination and Gallick and Timonen therefore cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the case allowed.

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Gallick and Baker

Claims 9 and 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Gallick in view of Baker. The combination of Gallick and Baker also cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 9 and 20, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The Combination of Gallick and Baker
Do Not Teach All of Applicants' Claim Limitations

To establish a prima facie case of obviousness, the proposed combination of Gallick and Baker must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The proposed combination of Gallick and Baker does not teach each and every element of claims 9, and 20. Claim 9 depends from independent claim 1 and includes the limitation "identifying, at said destination device, a callee identity associated with said utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call." Claim 20 depends from claim 12 and includes the limitation "means for identifying a callee identity associated with said voice utterance at said destination device, such that said callee identity is transmittable as an authenticated identity of said callee for a call." As discussed above, Gallick does not disclose "identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call" as claimed in the present application. Baker does not teach what Gallick lacks. Instead, Baker discloses a telecommunications system with a PBX. In fact, Baker also does not even address authentication. Because the proposed combination of Gallick and Baker fails to teach every element of claims 9 and 20, the combination cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the case allowed.

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No Suggestion or Motivation to Modify Gallick or
Combine of Gallick and Baker

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Gallick. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Gallick must come from the teaching of Gallick itself and the Examiner must explicitly point to the teaching within Gallick suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). There is no teaching in either Gallick or Baker suggesting "identifying, at said destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call" as claimed in the present application because neither reference even addresses authentication. Gallick discloses using voice identification software to analyze the speech of an answering party at the called facility and sending caller verification routines for an attempted identification of the called party. Gallick, column 6, lines 3-14. Baker discloses a telecommunications system with a PBX. As such, there is not teaching in either Gallick or Baker suggesting the proposed combination. The rejection should be withdrawn and the case allowed.

No Reasonable Expectation of Success
In the Proposed combination of Gallick and Baker

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Gallick and Baker. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There is no reasonable expectation of success to combine Gallick and Baker to disclose "identifying, at said

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destination device, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call" as claimed in the present application because neither reference even addresses authentication. Gallick and Baker together cannot work to achieve what neither reference discloses alone. As such, the proposed combination and Gallick and Baker cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the case allowed.

The Four Factual Inquires Required By The Supreme Court For An Obviousness Rejection Have Not Been Properly Considered, Determined, and Applied

Establishing a prima facie case of obviousness for claims 2, 3, 6, 9, 13, 14, 17, 20, 24, 25, and 28, which has not been accomplished, is not the end of obviousness analysis, it is the beginning. The rejection of these Applicants' claims under 35 U.S.C. § 103 are deficient because the proper factual inquiries have not been considered, determined, and applied as required by the Supreme Court in *Graham v. John Deere*. The rejection should therefore be withdrawn and the case allowed.

The Manual of Patent Examining Procedure §2141 explicitly states:

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary

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considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy. . .

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

Office policy has consistently been to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquires enunciated therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and

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(D) Evaluating evidence of secondary considerations.

Manual of Patent Examining Procedure §2141.

In over two years of prosecution, the Examiner has yet to even mention the four factual inquiries required by the Supreme Court in *Graham v. John Deere*, and all four factual inquiries have not been properly considered, determined, and applied in any of the office actions in this case.

The first factual inquiry that has not been properly considered and determined is ascertaining the differences between the prior art and the claims in issue. More particularly, in the present office action the Examiner has only identified elements in Applicants' claims not found in Gallick and then attempted to find a similar element in Bartholomew, McAllister, Timonen, or Baker to support an obviousness rejection. Such analysis is improper and incomplete. "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP §2141.02. Furthermore, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Id.*, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The analysis of the present office action is improper and incomplete because Examiner has not determined whether Applicants claims as a whole would have been obvious in view of a combination of Gallick and Bartholomew, McAllister, Timonen, or Baker as required by the Manual of Patent Examining Procedure. In fact, the Examiner has not even mentioned how the claim as a whole would be obvious in rejecting any claim. As such, the obviousness rejections should be withdrawn and the case should be allowed.

The second factual inquiry that has not been properly considered, determined, and applied is resolving the level of ordinary skill in the pertinent art. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining

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objectivity in the obviousness inquiry." MPEP §2141.03 citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). "The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The present office action fails to apply a single factor to consider in determining the level of ordinary skill in the art. In fact, in over two years of prosecution and four office actions, no analysis at all considering the level of one of ordinary skill in the art for the instant case has been performed. The rejection is therefore deficient and the case should be allowed.

Conclusion

To anticipate claims 1, 4, 5, 7, 8, 10-12, 15, 16, 18, 19, 21-23, 26, 27, 29, 30, and 35-39, Gallick must disclose each and every element as set forth in the claims 1, 4, 5, 7, 8, 10-12, 15, 16, 18, 19, 21-23, 26, 27, 29, 30, and 35-39 and be an enabling disclosure of claims 1, 4, 5, 7, 8, 10-12, 15, 16, 18, 19, 21-23, 26, 27, 29, 30, and 35-39. Because Gallick does not disclose or place one of ordinary skill in the art in possession Applicants' claims, Gallick cannot anticipate claims 1, 4, 5, 7, 8, 10-12, 15, 16, 18, 19, 21-23, 26, 27, 29, 30, and 35-39 within the meaning of 35 USC 102. Gallick alone or in combination with Bartholomew, McAllister, Timonen, or Baker does not establish a prima facie case of obviousness according to 35 USC 103. The proposed combination of Gallick and Bartholomew, McAllister, Timonen, or Baker fail to establish a prima facie case of obviousness because the proposed combinations present no suggestions or motivation to combine the references, there is no reasonable expectation of success in the

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proposed combinations, and the proposed combinations do not teach all of Applicant's claim limitations. Applicants therefore respectfully request the allowance of claims 1-39.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date:

10.19.04

By:

Respectfully submitted,


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